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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/899,418

07/03/2001

Gabriel G. Saucy

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3308

22442

7590

04/25/2005

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EXAMINER

WITHERSPOON, SIKARL A

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/899,418	<b>Applicant(s)</b> SAUCY, GABRIEL G.	
	<b>Examiner</b> Sikarl A. Witherspoon	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 is/are allowed.
- 6) ☒ Claim(s) 30-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/11/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itor et al (US 4,814,353) and further in view of Kijima et al (US 4,169,157).

The instant claims are drawn to a method of treatment for an ulcerative disease, i.e. gastritis, by administering a teprenone composition to a patient, wherein the composition comprises mostly the E-isomer.

Itor et al teach therapeutic and prophylactic agents for treating gastritis, said agent comprising a prenyl ketone, such as all isomers of 6,10,14,18-tetramethyl-5,9-13-17-nonadecatetraen-2-one (teprenone).

The differences between Itor et al and the instant claims are that Itor et al do not expressly teach the amount of a given teprenone isomer in the composition, and do not teach the method by which the teprenone (and geranylgeraniol) in said composition is made.

With regard to the first difference, as stated above, Itor et al do not teach the same amounts of teprenone present in the composition, as claimed herein; however, Kijima et al teach therapeutic preparations for peptic ulcers wherein teprenone is

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present in said preparation in an amount of 75.7%, as the inhibition rate to the development of restraint to the stress ulcer.

The examiner therefore takes the position that a person of ordinary skill in the art would be motivated to modify, or adjust the amount of teprenone in such compositions in order to obtain the most effective concentration that affords optimal inhibition and/or treatment of an ulcerative disease or condition.

With regard to the second difference, the examiner purports that absent a showing of some unexpected characteristic afforded to the teprenone compound, it is immaterial how the teprenone compound used in the composition to treat gastritis or other ulcerative conditions is made, since it is presumed that the teprenone itself is the same. Therefore, the instant claims are found obvious in view of the references recited above.

#### ***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter: claims 1-29 are drawn to a method of making teprenone. The closest prior art of record fails to teach or fairly suggest a method of making teprenone using genanylgeraniol as the primary reactant, as claimed herein.

#### ***Claim Objections***

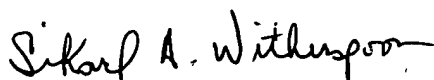
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Claims 16, 37 and 51 are objected to because of the following informalities: in the instant claims, the word, diphosphate (found with farnesyl) is incorrectly spelled. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sikarl A. Witherspoon whose telephone number is 571-272-0649. The examiner can normally be reached on M-F 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner  
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